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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/298,726	04/23/99	MADDALON	V 06023-71 (MI/

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EXAMINER

DEXTER, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/298,726

Applicant(s)
Maddalon

Examiner
Clark F. Dexter

Group Art Unit
3724



☒ Responsive to communication(s) filed on Mar 31, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) 3-7 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, and 8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group II (claims 1, 2 and 8) in the response filed March 31, 2000 (paper no. 7) is acknowledged. The traversal is on the ground(s) that the restriction is improper. This is not found persuasive because for the following reasons.

First, applicant is correct regarding the claims of groups I (claims 1, 2 and 8) and group II (claims 1, 3 and 7). The Examiner appreciates applicant recognizing this and pointing this out.

Regarding the restriction requirement, the Examiner respectfully disagrees with applicant's analysis. First, whether a claim is independent or dependent is of little consequence. As applicant is aware, all claims are considered as independent claims. Dependent claims are merely independent claims written in abbreviated or shorthand form. Thus, the grouping of the claims is based on the claimed subject matter and is not based on the form in which the claims are presented.

Second, the Examiner respectfully disagrees with applicant's position that the groups are directed to a combination/subcombination. Rather, the groups are directed to subcombinations useable together. Each group contains common claim 1 along with claims that defines the specifics of one of the subcombinations. Claim 1 is not a subcombination claim since it does not define any specific subcombination. Rather, claim 1 is simply a common claim; i.e., a claim which recites subject matter common to all groups and therefore not separable from any of the groups.

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Third, if it is applicant's position that the groups are not independent or distinct, such a statement will be considered if applicant submits evidence or identifies such evidence now of record showing the inventions to be obvious variants or clearly admits on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Regarding the species election, applicant argues that because all of the claims depend from claim 1, there is no additional burden on the Examiner to examine all of the claims. The Examiner respectfully disagrees. First, a format wherein the independent claim defines a generic claim and its dependent claims define two or more species is a common and generally typical claim format and a species election is usually required. Again, whether claims are written in independent or dependent form is merely a matter of form since all claims are considered as independent claims wherein dependent claims are merely written in shorthand form. Second, the burden requirement applies to restriction and not to species elections.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 3-7 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species, there being no allowable generic or linking claim.

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Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statement filed October 12, 1999 (paper #5) has been received and the references listed thereon have been considered.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the microprocessor as set forth in claim 1, line 8; the pivoting point being provided at the end opposite to the end connected to the motor as set forth in claim 2, line 5; and the two blades as set forth in claim 8, line 2 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

6. Claims 1, 2 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1, line 4, structural cooperation is not positively set forth for “a first motor”, particularly with respect to the rollers, and it is suggested to delete “for” and to change “thereof” to --the rollers-- or the like; in lines 4-5, structural cooperation is lacking for “a cutting assembly”; in line 5, structural cooperation is lacking for “a second motor”, particularly with respect to the cutting assembly; also in line 5, structural cooperation is lacking for “a third motor”, and in line 6 the recitation “for bringing ...” is vague and indefinite since sufficient structure has not been set forth to perform the recited function; in line 7, structural cooperation is lacking for “a reading system”; also in line 7, “suitable to detect” is vague and indefinite as to the function of the reading system, and it is suggested to delete “suitable”; in line 8, structural cooperation is lacking for “a microprocessor”; in line 14, the phrase “smaller than the width of the substrate” is vague and indefinite since the invention is being defined in terms of the workpiece (i.e., the substrate) which is not part of the claimed invention.

In claim 2, line 5, “or at the end opposite to the end connected to the motor” renders the claim vague and indefinite, particularly as to the location of the pivoting point since the recited locations are not considered equivalents.

In claim 8, lines 2-3, “at a distance corresponding to the total size of the mark in the substrate” is vague and indefinite since the invention is being defined in terms of the workpiece (i.e., the substrate) which is not part of the claimed invention.

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Prior Art

7. Further consideration of the claimed invention with respect to the prior art will be given upon clarification of the claimed invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



**Clark F. Dexter
Primary Examiner
Art Unit 3724**

cf
June 19, 2000